

REMARKS

Double Patenting Claim Rejections

The double patenting rejection of claims 1 to 19 and 26 to 57 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-15 of U.S. Patent No. 6,110,922 ("922 patent") was maintained. Office action at 3. In the response dated July 10, 2003, Applicants pointed out that the '922 patent is now in reissue as Application No. 10/356,794, filed August 29, 2002 (the "reissue application"). Therefore, a terminal disclaimer is currently not applicable because the present application and the reissue application are currently co-pending. See M.P.E.P § 804(I)(B). Applicants request that this rejection, as it relates to the claims under consideration, be made provisional and held in abeyance until allowable subject matter is indicated in either this application or the reissue application.

The rejection of claims 1 to 19 and 26 to 57 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 to 19, 26 to 31, 34 to 45, and 47 to 57 of co-pending Application No. 09/695,040 was also maintained. *Id.*, at 3. Applicants request that this provisional rejection, as it relates to the claims under consideration, be held in abeyance until allowable subject matter is indicated.

Claims 1, 19, and 20 to 22 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 15 to 19, 21 to 23, 26, and 28 of the co-pending reissue application No. 10/356,794. Office action at 4. Applicants request that this provisional rejection be held in abeyance until allowable subject matter is indicated in either this application or in the reissue application.

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Claim Rejections under 35 U.S.C. § 102

Claims 1, 19, 20 to 23, 26 to 43, and 45 to 60 were rejected under 35 U.S.C. § 102(e) as being anticipated by Link, *et al.*, U.S. Patent No. 6,110,922. *Id.*, at 5.

Applicants respectfully traverse this rejection.

In response to this rejection, Applicants submit herewith a declaration under 37 C.F.R. § 1.131 by Dugal S. Sickert to establish invention of the subject matter of the rejected claims prior to the effective date of the '922 patent.¹ Dugal S. Sickert is not the inventor of the subject matter of the rejected claim, the owner of a patent under reexamination, nor a party qualified under 37 C.F.R. §§ 1.42, 1.43, or 1.47. However, his declaration may be used to establish prior invention because "[t]he essential fact is priority of invention, and the Office may accept any satisfactory evidence of that fact" (*Ex parte Fostner*, 1903 C.D. 213, 105 O.G., 261 (Comm'r Pat. 1903)). Here, the declaration establishes that the Applicants were in possession of the subject matter described in the '922 patent prior to its filing date of December 29, 1998.

Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 102(e).

Claim Rejections under 35 U.S.C. § 112

Claims 1 to 19 and 23 to 43 were rejected as indefinite, presumably under 35 U.S.C. § 112, second paragraph. The Examiner states that the terms "heterocyclyl,

¹ Applicants note that through inadvertence no paragraph "8" appears in the declaration. However, the declaration is complete as filed.

heterocyclalkl etc.] [sic, heterocycl, etc.] for variables e.g. R10, R11, Ar" are indefinite because "the applicants do not exactly state which heteroatoms are present in these rings, how many of each are present in these rings, what size rings are intended and how many rings are present" [capitalization omitted]. Claims 2 to 19, 26, 29 to 33, 39, and 43 were also rejected because they are dependent on rejected claims. Further, claims 37 and 40 were rejected as indefinite under 35 U.S.C. § 112, second paragraph, because the claims recite "comprising" for compounds. Applicants respectfully traverse these rejections.

Applicants believe that claims 1 to 19 and 23 to 43 are definite, and point out that the specification defines the term "heterocycl" on page 15, line 18 to page 16, line 4, as a 4-, 5-, 6-, or 7-membered ring containing one, two or three heteroatoms independently selected from the group consisting of nitrogen, oxygen, and sulfur, as well as bicyclic, tricyclic and tetracyclic groups. The term "heterocyclalkyl" is defined in the specification on page 17, lines 6 to 7, as a heterocycl group attached to the parent molecular group through an alkyl group. The definitions provided by the specification clearly define the terms heterocycl and heterocyclalkyl to one of skill in the art. However, definiteness of claim language must be analyzed in light of the content of the particular application disclosure, and not in a vacuum. The Examiner must consider whether the claim as a whole apprises one of ordinary skill in the art of its scope. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ 2d 1279, 1283 (Fed. Cir. 2000) and the M.P.E.P. § 2173.02. Accordingly, claims 1 to 19 and 23 to 43 are definite and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

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Applicants believe that claims 37 and 40, which recite the term “comprising” are definite. Applicants intend for the claim to be constructed with open-ended language. For example, the cinnamide compounds may be comprise substituents that are not explicitly included in the limitations of the claims. The transitional term “comprising” is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the construct of the claim. See, e.g., *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ 2d 1608, 1613 (Fed. Cir. 1997) and the M.P.E.P. § 2111.03. Accordingly, claims 37 and 40 are definite and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is respectfully requested.

Claim Objections

Claims 20 to 25 and 45 to 60 have been objected to because they are non-elected claims and have not been cancelled. *Id.*, at 8. Applicants note that claims 20 to 23 and 45 to 60 have been rejected although the Examiner stated they were not under consideration. Thus, clarification of the status of these claims is requested.

The Examiner has objected to claim 37, stating that it does not exactly and definitely describe the invention. The Examiner states that “[d]iaryl cinnamide compound’ does not say exactly about the structures of the compounds because AR as recited by the applicants can be both phenyl/aryl as well as heteroaryl.” Claim 37 is directed to diaryl sulfide cinnamide compounds which comprise both a phenyl group and an unsubstituted aryl, unsubstituted heteroaryl, substituted aryl, or substituted heteroaryl group. Thus, it is clear that the claimed diaryl sulfide cinnamide compounds must have at least one phenyl group. Further, the claim does not contain a limitation of

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"AR." Accordingly, Applicants believe that the claim describes the invention exactly and definitely, and withdrawal of the objection is respectfully requested.

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant the extension of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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